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In re Application of Wadaka et al. :  
Serial No.: 09/778,872 : DECISION ON PETITION  
Filing Date: February 8 2001 : UNDER 37 C.F.R. 1.144  
For: FILM ACOUSTIC WAVE DEVICE AND ITS :  
MANUFACTURING METHOD AND CIRCUIT DEVICE :

This is a decision on the petition filed March 10, 2003, pursuant to the provisions of 37 C.F.R. § 1.144 to reconsider the restriction requirement. Petitioner urges that the the restriction requirement is improper and should be withdrawn. The Petition fee of \$130 has been paid. No additional fees are required.

The petition is **denied**.

A review of the record reveals the following. The examiner issued a restriction requirement between the apparatus claims (Group I) and the method of making claims (Group II) in an Office action dated April 2, 2002. The Applicant elected Group I with traverse and received an Office Action on the merits dated May 28, 2002 and a Final Office action on October 9, 2002. Upon review of the Office action, it has been determined that the restriction of the claimed invention had been properly grouped.

Petitioner has not established within the meaning of 37 CFR 1.111(b) and 37 CFR 1.144 sufficient reason to withdraw the restriction requirement. The restriction requirement, mailed April 2, 2002, clearly provides an appropriate explanation for insisting on restriction between the inventions of Group I and Group II (MPEP § 808.02). Group I and Group II have been shown to have a separate classification as well as the inventions are shown to be distinct as being a Process of Making and Product Made (MPEP § 806.05(f)). The examiner set forth other methods by the apparatus could have been made, such as: the two electrodes could be simultaneously formed, or the electrodes could be performed and adhered to the piezo element, or the piezo element could be performed and adhered to the bottom electrode. The Applicant's traversal in response to the election on the grounds that there is no undue burden on the examiner was addressed by the examiner in the first action on the merits dated May 28, 2002. The examiner stated that there was an undue burden on the examiner because the method of making limitations require an additional search in class 29, subclass 25.23.

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The Applicant's current argument that the examiner has not provided additional processes by which the product could be made is not persuasive because the examiner provided additional methods in the restriction requirement dated April 2, 2002. The Applicant's current argument that the examiner did not address the Applicant's traversal is not persuasive because the Examiner address the Applicant's arguments in the last paragraph of the first Action on the Merits dated May 28, 2002. The Applicant's current argument that the claims 17-23 were inadvertently withdrawn from consideration because they depend from claim 24 is not persuasive because claims 17-23 originally depended from cancelled claim 16, which was a method of making claim, and amended on May 2, 2002 to depend from newly added claim 60. The examiner appropriately withdrew the claims 60 and 17-23 from consideration on May 28, 2002 because they were drawn to the non-elected, method of making invention. The Applicant's argument that the present invention is directed to the process of forming a plurality of surface acoustic wave devices is not persuasive because the Applicant elected the Apparatus claims 24-40 on May 2, 2002.

For the above reasons, the Restriction requirement is considered proper. The application will be forwarded to the examiner for action on the Appeal Brief in due course.



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